

01-09-06

JAW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/715,793	
	Filing Date	November 18, 2003	
	First Named Inventor	J. L. Southard II	
	Art Unit	1713	
	Examiner Name	Roberto Rabago	
Total Number of Pages in This Submission	4	Attorney Docket Number	SCD 03-34

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Certificate of Mailing One Return Postcard
<div>Remarks</div> <div>Express Mail No. EQ122768282US</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MeadWestvaco Corporation		
Signature			
Printed name	Terry B. McDaniel		
Date	January 6, 2006	Reg. No.	28,444

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: *Express Mail			
Signature			
Typed or printed name	Susan C. Harrison	Date	January 6, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Express Mail No. EQ122768282US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/715,793 Confirmation No.: 4547
Applicants : John L. Southard, II and G. Frederick Hutter
Filed : November 18, 2003
TC/A.U. : 1713
Examiner : Roberto Rábago
Docket No. : SCD 03-34
Customer No. : **36876**
For: : Aromatic Carboxylic Acid-Modified Cyclopentadiene-Based
Hydrocarbon Resins

Honorable Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT
WITH TRAVERSE**

Dear Sir:

In response to the Office Action Summary mailed December 19, 2005, subjecting all of original claims 1-52 to a restriction requirement and having a shortened statutory period for response set to expire on January 19, 2006, the invention of the claims of Group II (claims 9-11, 23-25, 35-37, and 50-52 drawn to resins and composition made therewith) is elected for examination. The remaining originally filed claims of Group I are withdrawn from consideration. Nevertheless, the applicants respectfully traverse the restriction of claims made by the Examiner and the resultant election requirement.

TRAVERSAL

For the restriction and election requirement, the Examiner relies on the argument that "the product, which lacks any specific physical properties, could be made by other methods." It is respectfully submitted, however, that the product is effectively claimed as a "product by process." Therefore, for the restricted *product* claims to read on any infringing product, said infringing product must necessarily have been made by the restricted *process* claims, the dependency relationship of claim 9 on claim 1 being the most obvious example. Assuming the accuracy of this statement, it is respectfully requested that the Examiner explain exactly how "the product, which lacks any specific physical properties, could be made" by any other method? Alternatively, the Examiner may explain the inaccuracy of applicants' assumption statement. The applicants, in assuming the accuracy of the premise, cannot imagine the answer as to how the product, as claimed, could be made otherwise.

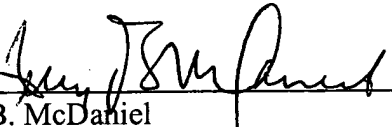
If the Examiner believes, for any reason, that personal communication will expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

No additional fees are believed to be due in connection with the filing of this amendment and response.

Respectfully submitted,

MEADWESTVACO CORPORATION

Date: January 6, 2006
3950 Faber Place Drive
Post Office Box 118005
Charleston, SC 29423-8005
Telephone (843) 740-2127


By 
Terry B. McDaniel
Attorney for the Applicants
Registration No. 28,444



EXPRESS MAIL NO. EQ122768282US
Case Docket No. SCD 03-34

CERTIFICATE UNDER 37 C.F.R. 1.10(a)

I hereby certify that this correspondence is being deposited with the United States
Postal Service as Express Mail in an envelope addressed to the Commissioner for Patents, P.O.
Box 1450, Alexandria, VA 22313-1450, on January 6, 2006.



Susan C. Harrison